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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RYOICHI SHIMIZU

Appeal No. 2003-1043
Application No. 08/883,322

ON BRIEF

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before THOMAS, BARRETT, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-14, which are all of the claims pending in this application.

We **AFFIRM-IN-PART**.

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Appellant's invention relates to a selectable recording frame rate video tape recorder. An understanding of the invention can be derived from a reading of exemplary claims 1 and 13, which are reproduced in the appendix to the brief.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Okauchi	5,229,890	Jul. 20, 1993
Suzuki	6,104,858	Aug. 15, 2000

Claims 1-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki in view of Okauchi.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 23, mailed Sep. 23, 2002) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 22, filed Jul. 5, 2002) and reply brief (Paper No. 24, filed Dec. 2, 2002) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellant has elected to group all the claims as standing or falling together. (Brief at page 4.) In fairness to appellant, rather than select a single claim (claim 13) which we find to be broader than all of appellant's arguments, we will select independent claim 1 which correspond more closely with appellant's arguments and independent claim 13 which we find to be the broadest claim.

CLAIM 1

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on

§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to

establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1.

Appellant argues that each of the independent claims requires, in part, recording a plurality of time codes together with the selected recording frame rate. (Brief at page 6.) We agree with appellant that independent claim 1 recites multiple formats together with the selected recording frame rate, but do not find a corresponding limitation in independent claim 13.

With respect to independent claim 1, the examiner maintains that Suzuki does not teach the two formats together and relies on the teachings of Okauchi to teach the non-drop and dropped frame formats together. (Brief at page 3.) Appellant argues that Okauchi teaches the use of a manual switch which would take either of two values/states and would only have either drop or non-drop frame format. (Brief at pages 7-8.) The examiner maintains that Okauchi teaches the use of two types at column 3, lines 4-40. (Answer at pages 10-11.) We disagree with the examiner and do

not find an express or clear implied teaching of the use of both together. Taking the examiner's alternative position that it would have been obvious to one of ordinary skill in the art at the time of the invention that "the user can operate the manual switch . . . to record both drop frame and non-drop-frame coded pulses together with the selected recording frame rate," (answer at page 11) we find no express or clear implied teaching of the use of both together in the teachings of Cytera and the examiner has not provided any (convincing) line of reasoning as to why it would have been obvious to one of ordinary skill in the art at the time of the invention to record both together. Therefore, we agree with appellant that the examiner has not established a ***prima facie*** case of obviousness of the invention recited in independent claim 1 and its dependent claims. We find similar limitations in the limitations of independent claims 6, 12 and 14 and will not sustain the rejection of these claims and their dependent claims.

CLAIM 13

Turning to claim 13, we do not find a corresponding limitation that both the drop frame and non-drop-frame data are stored together with the time code data. From our interpretation of independent claim 13, we do not find that both the drop frame and non-drop-frame data are necessarily stored together with the time code data. Claim 13 recites "separating a plurality of types of time code information and recording frame rate information according to a reproduced signal." We interpret this to only require that there be a plurality of types of time code information and recording frame rate

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information, which is clearly taught and suggested by Okauchi since there are both drop frame and non-drop-frame data possible and there is no requirement that they be stored together. Therefore, we do not find that appellants' arguments are commensurate in scope with the limitations recited in independent claim 13 are not persuasive thereto. Therefore, this argument is not persuasive, and we will sustain the rejection of independent claim 13.

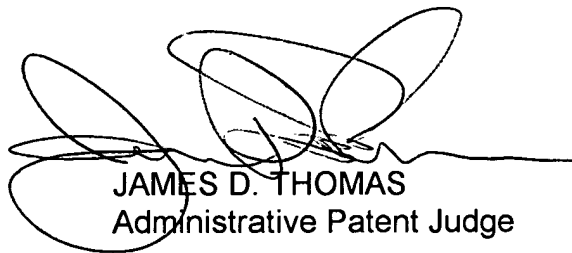
CONCLUSION

To summarize, the decision of the examiner to reject claims 1-12 and 14 under 35 U.S.C. § 103 is reversed, and the decision of the examiner to reject claim 13 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART



JAMES D. THOMAS
Administrative Patent Judge



LEE E. BARRETT
Administrative Patent Judge



JOSEPH L. DIXON
Administrative Patent Judge

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